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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,863	07/31/2003	Ronald D. House	112226	9069
27074 7590 08/29/2007 OLIFF & BERRIDGE, PLC. P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER MCLEAN, NEIL R	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 08/29/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction27074@oliff.com  
jarmstrong@oliff.com

<b>Office Action Summary</b>	Application No. 10/630,863	Applicant(s) HOUSE ET AL.	
	Examiner Neil R. McLean	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 5, 6, 8-10, 12 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5, 6, 8-10, 12 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Status of Claims**

1. Claims 1-4, 7, 11, 13-14 been canceled by applicant.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 5-6, 9-10, 12 and 15 have been considered but are moot in view of the new ground(s) of rejection.
3. With respect to applicant's argument that Frey et al. fails to disclose or suggest the distribution feature recited in Claim 8. Frey et al. teaches distributing the files to a removable storage device or sending the files to an email address (Column 5, lines 10-12).

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 5-6, and 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Molldrem, Jr. (US 6,985,673).

Regarding Claim 5:

Molldrem teaches a method of purchasing a portable digital storage media from a digital image forming device, comprising:

- selecting a portable digital storage media type (Column 11, lines 3-6);
- selecting a portable digital storage media amount (Column 9, lines 12-15);
- charging a transaction fee (Column 8, lines 58-64); and
- dispensing the portable digital storage media (58 in Figure 2B); and transferring a computer file from the digital image forming device to the portable digital storage media (Column 10, lines 57-61), before the step of dispensing the portable digital storage media (Column 11, lines 32-35).

Regarding Claim 6:

The method of claim 5, wherein the portable digital storage media comprises one or more of CD-ROM, DVD-ROM and CD-RW (Column 11, lines 3-6);

Regarding Claim 9:

Molldrem teaches a system for purchasing a portable digital storage media from a digital image forming device, the system comprising:

- a payment interface (30 in Figure 2A)
- a media distribution device for dispensing the portable digital storage media (58 in Figure 2B); and

a user input device (Keyboard 40, Selection Push Buttons 38 in Figure 2B) for selecting one or more of a portable digital storage media type and a portable digital storage media amount, wherein the portable digital storage media comprises one or more of CD-ROM, DVD-ROM and CD-RW (Column 11, lines 3-6); and

Wherein the media distribution device is a digital image forming device (Computer processor 74 in Figure 3; Column 11, lines 41-49), and the portable digital storage media is one or more of CD-ROM, DVD-ROM and CD-RW (Column 11, lines 3-6).

Regarding Claim 10:

Molldrem teaches a system for purchasing a portable digital storage media from a digital image forming device, the system comprising:

a payment interface (30 in Figure 2A)

a media distribution device for dispensing the portable digital storage media (58 in Figure 2B); and

a user input device (Keyboard 40, Selection Push Buttons 38 in Figure 2B) for selecting one or more of a portable digital storage media type and a portable digital storage media amount, wherein the digital image forming device is a digital photocopier (80 in Figure 3).

6. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Frey et. al. (US 6,369,908).

Regarding Claim 8:

Frey et al. teaches a system for purchasing a portable digital storage media from a digital image forming device, the system comprising:

a payment interface (Column 3, lines 19-21);

a media distribution device (Column 5, lines 10-17; e.g., send the files to an email address) for dispensing the portable digital storage media (Column 5, lines 21-23; CPU prompts user to remove storage device); and

a user input device for selecting one or more of a portable digital storage media type and a portable digital storage media amount (Column 3, lines 3-6);.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being anticipated by Frey et al. (US 6,369,908) in view of Nihei (US 7,098,942).

Regarding Claim 12:

Frey et al. teaches a system for transferring a computer file from a portable digital storage media, the system comprising:

a media distribution device for distributing a storage media (Step 238 in Figure 5);

a portable digital storage media read/write interface for coupling the portable digital storage media to the media distribution device (Column 5, lines 25-28 and 238 in Figure 5); and

a payment interface for accepting payment for a transaction in which the computer file is transferred from the portable digital storage media to the storage media (16 in Figures 1 and 2), wherein the storage media is paper and the media distribution device is one or more of a digital photocopier CD-ROM, DVD-ROM and CD-RW (Column 3, lines 3-6) and the media distribution device is a digital image forming device (CPU; Column 7, line 22 – Column 8, line 1).

Frey et al. does not teach wherein the storage media is paper.

However, Nihei in the same field of endeavor of image capturing and distribution teaches a capture system with two internal printers that can print images on two sheets of paper (Column 3, line 66 – Column 4, line 2).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have added a printer as taught by Nihei to the photo kiosk of Frey et al.

The suggestion/motivation for doing so would be to obtain a printout of the image data instead of just placing the data onto a removable medium e.g., CD, DVD, memory

card. The user may not have access to a printer elsewhere and may want an immediate print copy of the data, especially if they wish to have a tangible hard copy to show to others etc.

Regarding Claim 15:

The system of claim 12, further comprising:

a portable electronic device interface, wherein the portable electronic device interface is in communication with the portable digital storage media and wherein the portable digital storage media is controlled by a portable electronic device (Column 5, lines 25-28 and 238 in Figure 5).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fredlund et al. discloses a method for facilitating orders for image services.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



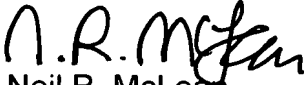
Art Unit: 2625

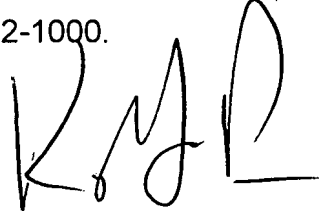
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. McLean whose telephone number is 571.270.1679. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571.272.7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Neil R. McLean  
08/21/2007

  
KING Y. POON  
SUPERVISORY PATENT EXAMINER